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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,024	01/29/2002	Anjana Rao	01997.001700.	2671

5514 7590 05/27/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SHIBUYA, MARK LANCE

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ 10/ CONTROL NO. 058,024	FILING DATE 1/29/02	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION RAO	ATTORNEY DOCKET NO. 01997,001700
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EXAMINER

M. SHIBUYA

ART UNIT

PAPER

1639

05252004

DATE MAILED:

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Commissioner for Patents

Communication

1. The amendment filed on 3/8/2004 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because the invention of elected Group I, claims 1-11 (now cancelled) are drawn to a method of screening for test compounds capable of modulating the activity of an anergy marker protein, the steps thereof comprising contacting the anergy marker protein with a plurality of test compounds; whereas, the invention of newly added independent claim 46 is drawn to a method for screening a test compound for the ability to **induce** anergy in **T cells**, comprising contacting T cells with the test compound; and the invention of the other newly added independent claim, *i.e.*, claim 74, is drawn to a method for screening a test compound for the ability to **heighten immune surveillance** in **T cells**.
2. The invention of elected Group I is independent and distinct from the inventions of claims 46-78 because the invention of Group I is drawn to screening for test compounds that modulate an anergy marker protein, which is are different modes of operation, functions and effects from screening compounds that induce anergy in living T cells or that heighten immune surveillance in living T cells. Furthermore, the invention of Group I is drawn to correlating the amount of binding of the test compound to the anergy marker protein, which is an *in vitro* measurement. The search required for cancelled Group I would be different from the searches required for newly added claims 46-78. The amendment adding claims 46-78 is therefore non-responsive to the requirement for restriction and election, mailed 11/02/2003.

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3. Furthermore, applicant is also non-responsive to the restriction and election requirement, filed 3/8/04, because applicant did not elect a single binding activity (see p. 10, para 5), as required in restriction and election requirement mailed 11/3/2003. Applicant asserts that the election of a single binding activity is "now moot in view of the amended claims." However, as noted above, the amendment to the claims is non-responsive, and will not be entered. See MPEP 821.03.
4. Applicant in the response filed 3/8/04, elected the species of a small molecule and the anergy marker GRG4 (accession number U61363), as well as Group I.
5. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Shibuya
Examiner
Art Unit 1639

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PADMASHRI PONNALURI
PRIMARY EXAMINER